

### **REMARKS**

In the Office Action, claims 1-8, 47-55, and 57-94 were rejected. Reconsideration of the rejections and allowance of all pending claims are respectfully requested.

#### **Double Patenting Rejection**

In the Office Action, the Examiner asserted a double patenting rejection of claims 1-8 and 47-55 as being unpatentable over claims 1-42 of U.S. Patent Application No. 09/940,065. Moreover, the Examiner emphasized that the present rejection is a *provisional* double patenting rejection.

In the interest of efficient prosecution, Applicants respectfully request that the Examiner hold in abeyance the double patenting rejection until the allowabilty of the claims is indicated. Although Applicants do not necessarily agree with the Examiner's rejection, Applicants will nonetheless consider filing a terminal disclaimer upon indication that the pending claims are allowable. That is, Applicants respectfully request that the discussion regarding the double patenting rejection be suspended until the allowabilty of the claims is determined.

#### **Rejection Under 35 U.S.C. § 103**

Claims 1-8, 47-55, and 57-94 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Henderson, U.S. Patent No. 3,403,240, in view of Duncan, U.S. Patent Application 5,198,053. Applicants respectfully traverse the rejection.

Claims 1-8, 47-55, and 57-94 are patentable because the cited references, either alone or in combination, do not disclose all of the recited features of the claims. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill

in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

**Claim 1 and the claims depending therefrom**

For example, the cited references fail to disclose or suggest “a portable power source electrically coupleable to a fluid-cooled induction heating cable to produce a varying magnetic field,” as recited in independent claim 1. In the Office Action, the Examiner stated that:

The Henderson (sic) in figures 1-4 and col. 2, line 23-col 4, line 33 discloses the features including the claimed portable induction unit with cooling except for the programmable power source controller.

The Henderson reference discloses a work unit 10 and an induction heating element 22 that is coupled to the work unit 10. *See* Henderson, col. 2, lines 23-32. However, the work unit 10 is not “a portable power *source*,” as recited in claim 1. More specifically, the work unit 10 is not a source of power. The work unit 10 receives high frequency induction heating power from a suitable source, such as a motor generator set, via source lines 30 and 32. *See* Henderson, col. 2, lines 32-36. The work unit 10 then couples the power produced by the source to the induction heating element 22. Thus, instead of being a power source, the work unit 10 is a switch that enables a user to have local control of the current produced by the actual power source. *See* Henderson, col. 4, lines 9-32. Therefore, the work unit 10 is not “a portable power *source*,” as recited in claim 1.

Furthermore, the “suitable source” of Henderson is not “a portable power source,” as recited in claim 1. The “suitable source” is not shown in any of the figures of the Henderson reference. However, the Henderson reference discloses that instead of moving the “suitable source” to a work area, the work unit 10 is placed in the work area and

incoming power is connected to the work unit 10 from the “suitable source.” See Henderson, col. 4, lines 14-16. Thus, the “suitable source” is not “a *portable* power source,” as recited in claim 1.

The Duncan reference fails to obviate these deficiencies of Henderson, nor does the Examiner argue that it does. Therefore, the cited references do not disclose all of the recited features of claim 1. Accordingly, independent claim 1 is patentable over the cited references. Claims 2-8 depend from independent claim 1 and are, therefore, also patentable over the cited references. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**Claims 57 and 79 and the claims depending therefrom**In addition, for the same reasons as indicated above with reference to claim 1, the cited references fail to disclose or suggest “a portable power *source* electrically coupleable to a portable fluid-cooled induction heating cable to produce a varying magnetic field,” as recited in claim 57, or “a portable power *source* electrically coupleable to a fluid-cooled induction heating cable to produce a varying magnetic field,” as recited in independent claim 79. Therefore, independent claims 57 and 79 are patentable over the cited references. Claims 58-67 and 80-86 depend from independent claims 57 and 79, respectively, and are therefore also patentable over the cited references.

**Claims 47, 68 and 87 and the claims depending therefrom**

Furthermore, and for similar reasons, the Henderson reference does not disclose “a power source operable to apply power to heat a workpiece” and “a cart operable to transport the power source...to the workpiece,” as recited in independent claims 47 and 87. Similarly, Henderson does not disclose or suggest “a power source operable to apply power to inductively heat a workpiece” and “a cart operable to transport the power source...to the workpiece,” as recited in independent claim 68.

As noted above, the Henderson reference discloses that the work unit 10 is not a power source because power is supplied to the work unit 10 from a "suitable external source," such as a motor generator. However, no illustration of the "suitable source" is provided in the Henderson reference, nor is there any suggestion that the "suitable source" is or even could be transported on a wheel cart. In fact, the Henderson reference suggests that the motor generator is not disposed on a cart since the work unit 10 has casters 138 and the work unit 10 is provided to be transported to areas inaccessible to conventional induction heating equipment, such as a motor generator. *See* Henderson, col. 4, lines 10-12. In fact, there would be no reason for the work unit 10 in the system of the Henderson reference if the "suitable source" were on a cart.

Therefore, the cited references do not disclose all of the recited features of claims 47, 68, and 87. Accordingly, independent claims 47, 68, and 87 is patentable over the cited references. Claims 48-55, 69-78, and 88-94 depend from independent claims 47, 68, and 87, respectively, and are, therefore, also patentable over the cited references.

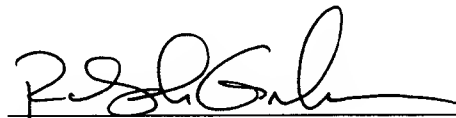
For all of these reasons, claims 1-8, 47-55, and 57-94 are patentable over the Henderson and Duncan references. Withdrawal of the rejection and allowance of the claims are respectfully requested.

**Conclusion**

In view of the remarks set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: September 27, 2004

A handwritten signature in black ink, appearing to read 'R. A. Graham', written over a horizontal line.

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